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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,106	06/08/2005	Helmar Van Santen	NL 021244	1512
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EXAMINER				
HIGGINS, GERARD T				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
05/11/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/538,106

Applicant(s)

VAN SANTEN ET AL.

Examiner

GERARD T. HIGGINS

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's response filed 09/15/2008 has been entered. Currently claims 10-21 are pending and claims 1-9 are cancelled.
2. The amendment filed 03/26/2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: applicant is attempting to introduce both "a spherical" and "an aspherical" lens into the disclosure. The Examiner saw this as a typographical error and that the actual portion of the disclosure should have read "an aspherical lens," particularly given the disclosure at page 3, lines 24-26. If the Examiner had interpreted this section as being an optional "a," he would not have made the objection to the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

3. Claims 18 and 21 are objected to because of the following informalities: the phrase "wherein the curable resin composition a platinum based catalyst" in claims 18 and 21 is awkward. The Examiner interprets these limitations as "wherein the curable

resin composition further comprises a platinum based catalyst.” Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 10-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With regard to claims 10-12 and 19, the Examiner does not find support for “wherein n and m represent lengths,” “wherein n represents a length,” or “n and m are lengths” for any of the first, second, third, or fourth components. Applicants did not define the number of repeat units of their polymers; furthermore, applicants are not supported for saying that the number of repeat units are necessarily the same. The Examiner notes that he was explaining his rejection under 35 U.S.C. 112, second paragraph in the previous Office action and was not suggesting any language for applicants to use to overcome the rejection. This rejection can be overcome by canceling the limitations, “wherein n and m represent lengths,” “wherein n represents a

length,” or “n and m are lengths” for any of the first, second, third, or fourth components as seen in claims 10-12 and 19.

With regard to claims 13 and 14, the Examiner does not find support to say that the replica “is **configured** to have a transparency.” This implies that additional steps have been taken that has “configured” the replica other than those explicitly set forth in the claims. Applicants are not supported for these additional steps.

With regard to claim 17, the Examiner does not find support to state that the optical component is “a spherical lens” in the specification as originally filed. Please see section 2 above.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 10-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claims 10 and 19, the phrase “R₄ = hydrogen, C₁-C₁₀-alkyl...” renders the claim indefinite because it makes it seem that R₁-R₄ is all of the members of the group following the equals sign. The Examiner will interpret this limitation as “wherein R₁, R₂, R₃, and R₄ are each individually selected from the group consisting of hydrogen, C₁-C₁₀-alkyl...**and** halogen atom, and at least one of R₁, R₂, R₃, **or** R₄ is hydrogen”.

With regard to claims 11 and 12, it is unclear if the substituents (R_1 and R_2) are the same nature as those seen in claim 10 because claims 11 and 12 use the terminology "further comprising," which means the silicon based reactive materials are different than, or in addition to, those presented in claim 10. The Examiner will interpret these claims to include "wherein R_1 has the same meaning as in claim 10" in claim 11, and "wherein R_1 and R_2 have the meaning as in claim 10" in claim 12.

With regard to claims 10-12 and 19, the claims are indefinite because the terms "m" and "n" are not defined and, therefore the full meets and bounds of the invention are not clear to one of ordinary skill in the art. The Examiner notes that a compound with an "m" and "n" value of 0, would be vastly different than a compound with an "m" or "n" value of 1, which would be vastly different than an "m" or "n" value of 1,000,000. The Examiner also notes that the as-filed disclosure likewise does not appear to provide any guidance on what range of values are appropriate for "m" and "n".

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 10-21 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. The evidence of public use or sale comes from the fact that applicants use a commercially available product Sylgard® 184 as their replica (see

provided product information on Sylgard® 184 acquired from <http://webservice.oxygenekatalog.dk/getdoc.aspx?DocID=10494>) as evidenced by US 4,120,585, which discloses the use of Sylgard® 184 as early as Oct. 17, 1978. The Examiner also notes that this compound may be acquired from multiple sources under different names, including from Dow Corning or GE Silicones.

With regard to claims 10-12 and 19, applicants state at page 5, lines 23-24 of their specification that Sylgard® 184 is a mixture of components 1-4 of their invention. Given the fact that a replica as claimed has no structure, the Examiner deems that a cured amount of Sylgard® 184 reads on applicants' replica as claimed. The Examiner notes that Sylgard® 184 may be cured using rapid heat cure (see features on page 1).

With regard to claims 13-15, 18, 20, and 21, given the fact that the Examiner has provided a curable silicone rubber composition identical to that claimed and disclosed in the specification; the Examiner deems that a cured amount of the Sylgard® 184 silicone rubber composition will inherently possess the transparency, the lack of birefringence, the portions by weight of each component 1-4, and the platinum catalyst as claimed.

With regard to claim 16, the product information for Sylgard® 184 state on the first page that the composition is an optically clear elastomer designed to be used as an optically clear product, which reads on applicants' optical component as claimed.

With regard to claim 17, while there is no disclosure that a cured amount of Sylgard® 184 is "a spherical lens, an aspherical lens, a lens array, a prism, a grating or another relief structure for optical applications, or a combination thereof" as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that "if the body of

a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction". Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art cured piece of Sylgard® 184 and further that the prior art structure which is a replica identical to that set forth in the present claims is capable of performing the recited purpose or intended use.

10. Claims 10-21 are rejected under 35 U.S.C. 102(b) as being anticipated by DePalma et al. (4,120,585).

With regard to claims 10-12 and 19, applicants state at page 5, lines 23-24 of their specification that Sylgard® 184 is a mixture of components 1-4 of their invention. DePalma et al. disclose a pliable prism made of Sylgard® 184 (col. 2, lines 18-30). The

prism may be cured using heat (col. 2, lines 26-28). Given the fact that the prism is interacting with the fingerprints of a user of the prism to replicate a fingerprint image and also that applicants provide no structure to their replica as claimed, the Examiner deems the prism of DePalma et al. to be a replica as claimed.

With regard to claims 13-15, 18, 20, and 21, given the fact that the Examiner has provided a curable silicone rubber composition identical to that claimed and disclosed in the specification; the Examiner deems that a cured amount of the Sylgard® 184 silicone rubber composition will inherently possess the transparency, the lack of birefringence, the portions by weight of each component 1-4, and the platinum catalyst as claimed.

With regard to claims 16 and 17, the prism of DePalma et al. read on an optical component and prism as claimed.

Response to Arguments

11. Applicant's arguments, see Remarks, filed 03/26/2009, with respect to the objection to the specification, the rejection of claims 10-12 under 35 U.S.C. 112, first paragraph, and the rejection of claims 13, 14, and 17 under 35 U.S.C. 112, second paragraph have been fully considered and are persuasive. The relevant rejections/objections have been withdrawn.

12. Applicant's arguments with respect to claims 10-21 have been considered but are moot in view of the new ground(s) of rejection.

Applicants have used a commercially available product to form their replica. A piece of the optically clear silicone Sylgard® 184 reads on applicants' replica. Given the fact that applicants' use Sylgard® 184 to form their replica, the Examiner deems that a cured piece of Sylgard® 184 will inherently possess the transparency, the lack of birefringence, the portions by weight of each component 1-4, and the platinum catalyst as claimed. The Examiner directs applicants' attention to US 4,904,865, which teaches at col. 6, lines 58-68 that Sylgard® 184 is platinum-catalyzed.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Examiner has provided another patent (US 5,519,082), which is a cured organohydrogensiloxane and a divinyl capped siloxane that cures by hydrosilation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERARD T. HIGGINS whose telephone number is (571)270-3467. The examiner can normally be reached on M-Th 10am-8pm est. (Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Bernatz, acting SPE for Carol Chaney, can be reached on 571-272-1505. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin M Bernatz/
Acting SPE of Art Unit 1794
May 8, 2009

Gerard T Higgins
Examiner
Art Unit 1794

/G. T. H./
Examiner, Art Unit 1794